

## REMARKS

Claims 1-5 are pending in this application. New claim 5 was added in this amendment. No new matter has been added.

Claims 1, 2 and 4 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Bush et al.*, U.S. Patent No. 5,475,585. Claim 2 has been rejected under 35 U.S.C. §103(a) as being unpatentable over *Bush et al.*, U.S. Patent No. 5,475,585 as applied to claim 1. The Applicants respectfully traverse the rejections. Favorable reconsideration is respectfully requested.

Specifically, the cited art, alone or in combination, does not disclose at least “means for communicating a digital advertisement” and “means for requesting, displaying and responding to digital advertising” as recited in the claim 1 and similarly recited in claims 4 and 5. According to the present invention, digital advertisements are stored in a database associated with a merchant computer and are transmitted from the merchant computer to the buyers computer over a network. In contrast, *Bush* discloses a video broadcasting system that transmits video menus to a television or video screen via RF carrier signals, and further incorporates credit-card swipers and special keypads for user input (col. 3, lines 21-30; col. 5, lines 34-44, line 65 to col. 6, line 9; col. 7, lines 22-35). This configuration is completely different from the claimed features in the present application.

Under the MPEP, the USPTO must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application (MPEP 2181). If a prior art reference purportedly teaches identity of function to that specified in a claim, then the Examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function (MPEP 2182). If the specification defines what is meant by the limitation for the purposes of the claimed invention, the examiner should interpret the limitation as having that meaning (MPEP 2182).

Applicant submits that the Examiner has not met the burden imposed by the MPEP to explain how the configuration in *Bush* is equivalent to the present claims. The communication channel in *Bush* is separate and distinct from the broadcast channel that delivers a menu to the user terminal, and it delivers the purchase message to a different destination from the source of

the advertisements (menu). There is no mention of any kind of network transfer protocols or hypertext conventions of the WWW (see, e.g. specification page 11, second paragraph).

Accordingly Bush does not disclose, teach or suggest a purchase means or the other means set forth in the pending claims.

With regard to the Examiner's comments in the Advisory Action, the Applicant is not asking for limitations in the specification to be read into the claims, but is merely asking that examination of the present application abide by the requirements of 35 U.S.C. §112(6), as discussed above. The Advisory Action stated that "the only structure needed to perform the recited functionality is read into the claims from the specification. In the instant case, a processor, storage device and network (as taught by the Bush reference) are needed to perform the recited functionality." This statement flies in the face of logic. Following this line of reasoning to its logical conclusion, any algorithmic process or apparatus would become anticipated or obvious once any reference discloses a processor, storage device and network.

More importantly, this reasoning is in conflict with the current state of the law regarding means-plus-function limitations in algorithmic claim elements. In a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm. See *WMS Gaming v. International Game Technology*, 184 F.3d, 1339 (Fed. Cir. 1999). Means plus function limitation must be read to include any necessary components of that algorithm. See *Globetrotter Software v. Elan Computer Group* 236 F.3d 1363, (Fed. Cir. 2001).

The "means for communicating a digital advertisement" is clearly disclosed as being communicated by a merchant computer over a computer network, having advertisements stored in databases (see, e.g., specification pages 10-11). In contrast, *Bush* discloses a transmission being made by a transmitting source using a video signal that includes characters generated from a video character generator 206 (col. 1, lines 56-67; col. 3, lines 1-7; col. 5, lines 50-59; col. 6, lines 25-34). Also, the "means for requesting, displaying and responding to digital advertising" are supported in the specification, for example, on pages 11-13, and illustrate the use of links, and provides HTML forms for interacting with users. No such structure is taught or suggested in *Bush*.

For at least these reasons, the Applicants submit that the rejection under 35 U.S.C. §102 and §103 are improper and should be withdrawn. An early Notice of Allowance is earnestly requested. If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (115274-00015) on the account statement.

Respectfully submitted,  
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